

Appl. No. 09/626,063

R E M A R K S

Claims 1-24 have been cancelled. New claims 25-48 have been added.

Claims 1-24 were considered in the Office Action.

5 Claims 1, 2, 7, 8, 17-20 and 24 stand rejected under 35
U.S.C. 102(e) as being anticipated by Camara et al., U.S.
Patent 6,373,507 (hereinafter Camara). Claims 1, 2, 7, 8, 17-
20 and 24 stand rejected under 35 U.S.C. 102(e) as being
10 anticipated by Machida, U.S. Patent 6,642,943 (hereinafter
Machida). Claims 9, 10, 15 and 16 stand rejected under 35
U.S.C. 102(e) as being anticipated by, or, in the alternative,
under 35 U.S.C. 103(a) as being obvious over Camara. Claims
3, 4, 11 and 12 stand rejected under 35 U.S.C. 103(a) as being
unpatentable over Camara as applied to claim 2, and further in
15 view of Watanabe, U.S. Patent 6,144,468. Claims 5, 6, 13 and
14 stand rejected under 35 U.S.C. 103(a) as being unpatentable
over Camara as applied to claim 2, and further in view of
Nakatsuma et al., U.S. Patent 6,115,132 (hereinafter
Nakatsuma). Claims 3, 4, 11 and 12 stand rejected under 35
20 U.S.C. 103(a) as being unpatentable over Machida as applied to
claims 2 and 10, and further in view of Watanabe. Claims 5,
6, 13 and 14 stand rejected under 35 U.S.C. 103(a) as being
unpatentable over Machida as applied to claim 2, and further
in view of Nakatsuma. Claims 21-23 stand rejected under 35
25 U.S.C. 103(a) as being unpatentable over Camara as applied to
claim 20, and further in view of Watanabe and Nakatsuma.

The disclosure is objected to on page 4, line 21 because of an incorrect element number.

30 Support for the newly added claims is found, for example,
in at least the following locations:

Claims 25,35,48: pg 4, lines 14-17, pg 9, lines 1-4

Appl. No. 09/626,063

5 Claim 35: see also pg 11, line 1-pg 12, line 5
 Claims 26,37: originally filed claim 1
 Claims 27-28,37-39: pg 9, lines 19-21
 Claims 29-31,40,41: pg 8, lines 18-20
 Claims 32,43: pg 10, lines 4-6
 Claim 33: pg 10, lines 7-8
 Claims 34,44: pg 10, lines 8-10
 Claim 36: pg 4, lines 14-17
 Claim 42: pg 9, lines 18-20
10 Claim 45: originally filed claim 11
 Claim 46: originally filed claim 12
 Claim 47: originally filed claim 13

No new matter has been added.

15 The Applicant believes that the currently pending claims
are not anticipated by or obvious over the cited references
for at least the reasons set forth below, and respectfully
requests reconsideration.

Claim 25

The cited references do not disclose or suggest:

20 "A method of scanning an image to a location, the method
comprising:

 detecting a drag and drop operation wherein a first icon
is dragged to a location indicator and dropped on said
location indicator;

25 opening a connection between a scanner associated with
said first icon and said location, wherein said location is
associated with said location indicator;

 causing said scanner to scan said image; and
 storing said image in said location."

BEST AVAILABLE COPY

Appl. No. 09/626,063

(Claim 25, emphasis added)

The above highlighted features are not anticipated by the cited references and would not have been obvious to a person with ordinary skill in the art having the cited references.

5 None of the cited references disclose detecting a drag and drop operation wherein a first icon is dragged to an indicator for a location in which an image may be stored. Camara discloses traditional scanner control software with menus and pull-down lists for initiating a scan and selecting a
10 destination (see Camara, col. 5). Therefore, Camara does not disclose or suggest the drag and drop operation for scanning a document to a particular location.

Machida does disclose a drag and drop operation in which a scanner icon is dropped on a printer icon:

15 FIG. 7 is a view showing an example of a copying function setting screen displayed on the CRT 16 of the data processing apparatus shown in FIG. 2. When the scanner icon shown in FIG. 5 is dragged and dropped on the
20 printer icon, if such a combination is judged to be effective, this combination is displayed on the CRT 16. (Machida, col. 10, lines 46-51)

However, Machida does not disclose or suggest that the drag and drop operation causes the scanner to scan the image. Rather, Machida's drag and drop operation opens a window or
25 screen with settings for the scanner and printer, so that a copy operation may be initiated by the user:

30 Therefore, a screen as in FIG. 7 is displayed such that the user of the data processing apparatus can operate these two peripheral devices as if one device, thereby causing the user to be able to unconsciously use the two peripheral devices as one device. It should be noted that, when the combination of the devices designated by a drag-and-drop operation is changed, the displayed setting

Appl. No. 09/626,063

screen of FIG. 7 is also changed.
(Machida, col. 10, line 65 - col. 11, line 5)

The Applicant respectfully disagrees that Machida, col. 46, lines 55-67, discloses that other devices such as a PC or other devices shown in FIG. 5 for storage may be used in place of Machida's printer. Machida, col. 46, lines 55-67 indicates that "plural data generation sources" may be combined. A storage location is clearly not a data generation source. Furthermore, there is no motivation in Machida or the other references to extend the meaning of Machida's "data generation source" to include a storage location. The purpose of Machida's combined setting screens for multiple data generation sources is so that the user may control and configure the data generation sources in one location or screen. A storage location, in contrast, does not have a settings window like Machida's printer and has no need to be grouped in a settings window with another data generation source like a scanner. Therefore, the Applicant respectfully disagrees with the Examiner's interpretation that Machida's scanner can be combined with a PC to store scanned image data in the PC. This interpretation is simply not disclosed nor suggested by Machida.

Even if, for the sake of argument, a scanner and a storage location were combined by Machida in a single settings window, this combination would still not disclose or suggest the drag and drop operation claimed in Applicant's claim 25. Machida's drag and drop operation causes a settings window to be opened, requiring further user control. Applicant's drag and drop operation causes a scanner to scan an image and store it in the destination location, not just to open another settings window for a user. To anticipate a claim for a patent, a single prior source must contain all its essential

Appl. No. 09/626,063

elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986). The cited references, as discussed above, do not contain all essential elements of Applicant's claim 25. The Applicant believes that the claim
5 25 is allowable over the cited references and respectfully requests reconsideration.

Dependent claims 26-34 depend ultimately upon independent claim 25 which is allowable over the cited art as discussed above. These dependent claims are likewise in condition for
10 allowance at least because they depends on an allowable independent claim. However, dependent claims 26-34 are independently allowable at least in that they recite particular features which, when combined with the elements of the independent claim, are not disclosed or suggested in the
15 cited references. For example, claim 32 recites:

"The method of claim 25, further comprising **automatically converting said image to a different document format before said storing.**"

(Claim 32, emphasis added)

The cited references do not disclose or suggest
20 automatically converting the image to a different document format before storing, particularly as part of a single drag and drop scanning operation. Camara discloses a menu allowing the user to select a format for an image (see Camara, col. 5,
25 lines 21-22.) Camara does not disclose or suggest automatically converting the image. Similarly, Machida discloses displaying an operational panel or property screen, allowing the user to select image properties, rather than automatically converting the image to a different document
30 format before storing. The Examiner has cited Machida, col. 28, lines 21-34, in which input and output settings for an

Appl. No. 09/626,063

image may be determined. However, Machida discloses only that optimum settings are determined, then displayed on a property screen. A user must then adjust the settings if desired and cause the image to be converted. None of the cited references disclose automatically converting an image to a different document format before storing. Again, to anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., supra.

As another example, claim 34 recites:

"The method of claim 25, wherein said connection comprises an FTP connection."

(Claim 34, emphasis added)

The cited references do not disclose transferring an image across an FTP connection as part of a single drag and drop scanning operation.

Claim 35

The cited references do not disclose or suggest:

"An apparatus for controlling an image scanning process, comprising:

- a. at least one computer readable medium; and
- b. computer readable program code stored on said at least one computer readable medium, said computer readable program code being automatically executed when a first displayed element is dragged to and dropped upon a second displayed element, said computer readable program code comprising:
 - i. program code for establishing a connection

Appl. No. 09/626,063

between a scanner associated with said first displayed element and a destination storage location associated with said second displayed element;

- ii. program code for causing said scanner to scan at least one image; and
- iii. program code for transferring said at least one image from said scanner to said destination storage location and storing said at least one image in said destination storage location."

(Claim 35, emphasis added)

The arguments for allowability set forth above with respect to claim 25 are repeated, but specifically directed to the apparatus of claim 35. Again, the cited references do not disclose a scanning operation that is executed based on a drag and drop operation.

Claim 36 is believed allowable as depending from an allowable base claim and is further believed allowable in that the cited references do not disclose or suggest:

"The apparatus of claim 35, wherein said computer readable program code is executed without further user intervention after said first displayed element is dragged to and dropped upon said second displayed element."

(Claim 36, emphasis added)

As discussed above, the cited references all disclose more user control than a drag and drop operation to perform a scanning operation.

Dependent claims 37-47 depend ultimately upon independent claim 35 which is allowable over the cited art as discussed

Appl. No. 09/626,063

above. These dependent claims are likewise in condition for allowance at least because they depends on an allowable independent claim. However, dependent claims 37-47 are independently allowable at least in that they recite particular features which, when combined with the elements of the independent claim, are not disclosed or suggested in the cited references. For example, claim 43 recites:

"The method of claim 35, said computer readable program code further comprising **program code for converting said at least one image to a different document format before said transferring and said storing.**"

(Claim 43, emphasis added)

The cited references do not disclose or suggest converting the image to a different document format before storing, particularly as part of a single drag and drop scanning operation.

As yet another example, claim 44 recites:

"The apparatus of claim 35, wherein said transferring comprises **transferring said at least one image across an FTP connection.**"

(Claim 44, emphasis added)

The cited references do not disclose transferring an image across an FTP connection as part of a single drag and drop scanning operation.

Claim 48

The cited references do not disclose or suggest:

Appl. No. 09/626,063

"An apparatus for scanning and transferring images, comprising:

means for detecting a drag-and-drop of a scanner-related icon to a location-related icon;

means for automatically causing a scanner associated with said scanner-related icon to scan at least one image when said drag-and-drop is detected; and

means for automatically transferring said at least one image to a storage location associated with said location-related icon when said scan of said at least one image is complete."

(Claim 48, emphasis added)

The arguments for allowability set forth above with respect to claim 25 are repeated, but specifically directed to the apparatus of claim 48. Again, the cited references do not disclose or suggest scanning and transferring images automatically based on a simple drag and drop operation.

The Applicant believes that the currently pending claims are allowable over the cited references and respectfully requests the timely issuance of a Notice of Allowance.

Dated: 6/29/04

Respectfully submitted,
KLAAS, LAW, O'MEARA & MALKIN, P.C.

By: Guy K. Clinger

Guy K. Clinger, Esq.
Registration No. 42,422
1999 Broadway, Suite 2225
Denver, CO 80202
(303) 298-9888
Fax: (303) 297-2266